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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,132	06/09/2005	Toshiyuki Kawaguchi	P/2850-109	2257
2352                      7590                      11/25/2008 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
HARRIS, GARY D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
11/25/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/538,132

**Applicant(s)**

KAWAGUCHI ET AL.

**Examiner**

GARY D. HARRIS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)  
Paper No(s)/Mail Date 5/12/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

Declaration regarding translation error, submitted on 8/25/2008 is acknowledged by examiner.

### ***Response to Arguments***

Applicant's amendment to claims has overcome 112 rejections. Applicant's arguments page 7, filed on 8/25/2008 have been fully considered but they are not persuasive. Applicants argue that the imaginary part of the complex magnetic permeability increases steadily with frequency. However, as examiner has previously stated, the patent office does not have the facilities to measure magnetic permeability. Given the examiner sees no clear manner in which to relate the complex magnetic permeability values to the electromagnetic noise suppressor, and the PTO does not have means to provide complex and imaginary part measurement, this appears to be the only criteria the examiner can apply to the claimed values. Should applicants confirm that this is a reasonable assumption/means of evaluation, and will provide file wrapper estoppel, then the rejection can be reevaluated, as it will be if any explanation that actually provides a means of evaluation. Hence, how the thickness and resin of the composite layer relates to the permeability (imaginary and complex) remains impossible for the examiner to determine how these values are interrelated as sufficient information is lacking. Lacking any clearly determinable correspondence or evidence to the contrary, the Sakurai et al. 6,869,683 material may be expected to provide a permeability values as claimed. Additionally, the magnetic materials dispersed in the

binding agent without crystallizing reads on any amorphous material and could include a magnetic tape. Applicant has removed polyurethane and polysiloxane from the list of claimed binding agents. However, Senda et al. '417 disclose the use of phenols, epoxy, vinyl, acrylate and rubber (Col. 15, Line 24-25).

For convenience the rejection is substantially repeated:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senda et al. US 5,990,417.

As to Claim 1, Senda et al. '417 discloses an electromagnetic noise absorbing material and relationship of relative magnetic permeability (Col. 1, Line 24-34) and further discloses an imaginary part of a relative magnetic permeability more than 102 in the band of a few hundred MHz (Col. 24, Line 62-65). Senda et al. '417 does not disclose the imaginary part H of a complex magnetic permeability at 8 GHz higher than the imaginary part L of a complex magnetic permeability at 5 GHz. However, these

properties are inherent because the applicants and the inventors teach virtually identical structures with similar materials. The physical properties of similar materials will inherently or necessarily be similar. The burden of proof is shifted to the applicant to show the prior art properties are different from those claimed. See *In re Fitzgerald*, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980). Senda et al. '417 discloses a thickness of 0.1 microns (Col. 10, 11, Line 54-67, 1-2 respectively). Senda et al. '417 disclose the use of phenols, epoxy, vinyl, acrylate and rubber (Col. 15, Line 24-25)

As to Claim 3, Senda et al. '417 discloses different manufacturing methods for depositing the magnetic material including physical vapor deposition (Col. 11, Line 51-52).

As to Claim 5, 6 & 7, Senda et al. '417 discloses the use of phenol resins, epoxy resins, (applicants hardening resins) vinyl resins, acrylate resins, or synthetic rubber (applicants resin or rubber) (Col. 15, Line 24-25).

As to Claim 13 & 14, Senda et al. '417 discloses a thickness of 0.1 microns within the limitations of the claim (Col. 10, 11, Line 54-67, 1-2 respectively). Senda et al. '417 illustrates a relationship between relative permeability and frequency that would include frequencies in the GHz scale (see figure 37-38) the heterogeneous structure where the binding agent and a magnetic material are integrated on the nm scale would read on any magnetic material in contact with any heterogeneous material. The spacing

distance of less than 10nm as claimed would be inherently met by Senda et al. '417. It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary D. Harris/  
Examiner, Art Unit 1794

/Holly Rickman/  
Primary Examiner, Art Unit 1794

### Search Notes (continued)



Application/Control No.

10/538,132

Examiner

GARY D. HARRIS

**Applicant(s)/Patent under Reexamination**

KAWAGUCHI ET AL.

Art Unit

1794

SEARCHED

Class

Subclass

Date \_\_\_\_\_

Examiner

### SEARCH NOTES (INCLUDING SEARCH STRATEGY)

DATE \_\_\_\_\_

EXMR

updated search history

11/13/2008

GH

## INTERFERENCE SEARCHED

## Class

Subclass

Date \_\_\_\_\_

Examiner